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In re Application of
Eugene S. Smotkin
Serial No. 09/891,200
Filed: June 26, 2001
For: ELECTROLYTE COMPONENTS FOR USE
IN FUEL CELLS (AS AMENDED)

DECISION
GRANTING
PETITION

This is a decision on the December 21, 2007 "PETITION UNDER 37 CFR 1.181."

Applicant filed appeal briefs on July 11, 2007 and October 3, 2007, which were held non-compliant under 37 CFR 41.37 by the examiner in communications mailed August 10, 2007 and November 21, 2007, respectively. In both cases the examiner held the briefs to be non-compliant based on their inclusion of 'subject matter exceed[ing] applicant's instant invention' within the Summary of Claimed Subject Matter section of the brief.

The instant petition was then timely filed on December 21, 2007 and is before the Director of Technology Center 1700 for consideration. (No fee is due for this petition.) The petition requests that the objections raised by the communications of August 10, 2007 and November 21, 2007 be withdrawn, and the brief of either July 11, 2007 or October 3, 2007 be accepted. An additional revised brief was filed along with the instant petition.

The petition is **GRANTED** for the reasons below.

DECISION

The brief summary section must contain a summary of the claimed subject matter of each independent claim on appeal, with reference to the corresponding portions of the specification, but may contain additional material as well. As noted in the Federal Register (69 Fed. Reg. 49959) when the current version of 37 CFR 41.37 was published, 'the determination of how "concise" the explanation must be will need to be determined on a case-by-case basis...

Appellant may include any other information of record which will aid the Board in considering the subject matter of each independent claim.' The examiner's requirement to limit the Summary of Claimed Subject Matter to strictly the claim elements is thus incorrect.

Applicant requests that either the July 11, 2007 brief or the October 3, 2007 brief be retained as the brief before the Board, without any apparent preference. In reviewing both briefs, it appears that the October 3, 2007 brief contains a more detailed 'mapping' of the claim elements against the specification than does the July 11, 2007 brief. It thus appears that the October 3, 2007 brief would be somewhat more useful to the Board, and therefore this is the brief that will be retained as applicant's appeal brief before the Board.

As the appeal brief filed October 3, 2007 was compliant with 37 CFR 41.37, applicant's petition is hereby **GRANTED**.

The examiner shall consider the appeal brief of October 3, 2007 and take appropriate action in response thereto. The revised briefs of July 11, 2007 and December 21, 2007 shall not be entered.

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